

REMARKS

Claims 25-31 and 33-39 were pending in this application. The Applicants have cancelled claims 25-31 and 33-39 without prejudice to prosecuting these same, or similar claims, in subsequently filed applications.

Finally, the Applicants have added claims 40-49 in the instant correspondence. The Examiner made the following rejections:

- (1) The Examiner rejects claims 25 and 28-31 under 35 U.S.C. 102(b).
- (2) The Examiner rejects claims 25-31 and 33-39 under 35 U.S.C. 103(a).

The Applicants believe the present amendments, and the following remarks, traverse the Examiner's rejections. These remarks are presented in the same order as they appear above.

(1) & (2) The Art Rejections Are Moot

For the reasons set out in the Office Action Response, mailed May 15, 2003, the Applicants maintain that claims 25-31 and 33-39 are neither anticipated or obvious in view of the art cited by the Examiner in the prosecution of the instant application. However, in order to advance business interests and without acquiescing to any of the arguments raised by the Examiner; the Applicants have cancelled claims 25-31 and 33-39 without prejudice to prosecuting these same (or similar) claims in subsequently filed applications.

The Applicants introduce, in the instant correspondence, new claims 40 -49. This new claim set recites embodiments of the present invention which highlight additional elements of the claimed embodiments of the present invention which are neither described or suggested by the prior art of record.

Specifically, these embodiments claim (in part) compositions and methods which recite a *face seal* comprising a *region to intensified contact, interior to the outer peripheral edge* that redirects incoming dirt and debris particles out of the region of intensified contact.

The Examiner cites U.S. patent 3,497,225 to Workman, to advance both the pending rejections under 35 U.S.C. 102 & 103. The '225 patent to Workman, however, is silent on both face seals and regions of intensified contact *interior* to an outer peripheral edge. Given

the '225 patent to Workman is silent on these elements as claimed in the instant application; by definition the '225 to Workman support a rejection under 35 U.S.C. 102.¹

In regards to obviousness, the '225 patent to Workman teaches an area of lower pressure adjacent to the alleged textured features.² In contrast, the specification of the present invention teaches the;

"placement of the circumferentially located protrusions adjacent but interior to the outer peripheral edge is preferable because these protrusions provide a point of intensified contact that redirects the incoming dirt and debris particles out of the contact band and *into the low pressure areas*. This washes away the abrasive particles and prevents them from accumulating in the contact band."³

The Applicants' specification, therefore, teaches away from the '225 patent by configuring a region of intensified contact which generates an area of low pressure *outside* the seal in contrast to an area of low pressure *inside* of the seal edge, e.g. in an annular groove, as taught by Workman in the '225 patent. Therefore, given the '225 patent to Workman would likely lead an investigator in a direction divergent from the path taken by the Applicant, the '225 patent may not support a rejection under 35 U.S.C. 103. See, *Para-Ordnance Manufacturing v. SGS Importers International*, 37 USPQ2d 1237,1241 (Fed. Cir. 1995) (quoting *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994)).

While the Applicants have described the deficiencies of the '225 patent to Workman in detail, they submit that (in view of the pending claim set) the balance of the cited art is equally deficient and they invite the Examiner to consider the same.

¹ It is well settled law that a single reference must disclose each limitation of a claim in order for that reference to anticipate that claim. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).


² "While the shaft is rotating, it seems probable that the pumping action of dynamic sealing element 16 would produce a relatively low pressure zone in annular groove 34." U.S. Patent 3,497,225, Col.5, ll. 36-38.

³ Patent application, as filed on July 17, 2000, p. 10, ll.12-19.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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